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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,848	07/21/2003	Craig Richard Gerbi	017516-006810US	6559

51947 7590 11/06/2006

PATENT DEPT  
INTUITIVE SURGICAL, INC  
1266 KIFER RD  
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SUNNYVALE, CA 94086

EXAMINER

POUS, NATALIE R

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/624,848	GERBI ET AL.	
	Examiner	Art Unit	
	Natalie Pous	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18, 19 and 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/03</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Applicant's arguments, see pages 4-7, filed 10/2/06, with respect to the rejection(s) of claim(s) 18, 19 and 21-31 under Wright have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as a matter of design choice.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 18, 19, 21, 22, 30 and 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Wright as a matter of design choice.

Wright teaches a tool guide comprising the following:

- an elongate body (24) defining opposed ends and a passage extending within the body between opposed ends (fig. 1); and an engaging formation (fig. 1), a surgical instrument (12) passing through may be guided to a surgical site (14) in a

patient body when the elongate body is inserted through an aperture of the patient body (fig. 1)

- wherein the engaging formation comprises a socket formation (24)
- an inlet which leads into passage (34), the inlet being arranged to be accessible from outside the patient body (fig. 1) when the tool guide is mounted in the aperture, the socket formation being positioned adjacent the inlet, and an outlet (44) which leads from the passage, the outlet being arranged to be positioned within the patient body (14) when the tool guide is mounted on the patient body (fig. 1).
- the socket formation (24) comprises a circumferentially extending surface (42) defining at least part of the passage, the surface tapering radially inwardly in a direction away from the inlet (fig. 2).
- a cross-sectionally circular tubular portion defining the outlet (32).
- wherein all of the cross-sectionally circular tubular portion tapers radially outwardly in a rearward direction away from the outlet (44).

Wright fails to teach wherein the engaging formation of the tool guide is defined within the passage of the body. Instead, Wright teaches wherein the engaging formation is on the outside of the body. It would have been an obvious matter of design choice to provide the engaging formation on the inside of the tool guide, since applicant has not disclosed that providing the engaging surface on the inside of the device provides any advantage over providing the engaging surface on the outside of the tool, and it appears that the device of Wright performs the task of engaging the elongate

body to the robotic arm equally well as that of the disclosed application. Further, it has been held that mere reversal of the essential working parts of a device involves only routine skill in the art. In re Einstein 8 USPQ 167.

Claims 23 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Wright as a matter of design choice, and further in view of Ciccolella et al. (US 6224608).

Wright as a matter of design choice teaches all limitations of preceding dependent claims 18, 19, 21 and 22 as previously described, but does not teach wherein the outer surface defines at least one gripping formation and wherein the gripping formation comprises a rib extending helically around the outer surface. Ciccolella teaches a tissue holding device wherein the outer surface comprises a gripping formation comprising a helically extending rib (12) in order to maintain the desired positional relationship between the tool guide and the body tissue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wright as a matter of design choice with a gripping formation comprising a helically extending rib in order to maintain the desired positional relationship between the tool guide and the body tissue.

Claims 23 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright as a matter of design choice, and further in view of Honkanen et al. (US 4655752).

Wright as a matter of design choice teaches all limitations of preceding dependent claims 18, 19, 21 and 22 as previously described, but does not teach the following:

- Wherein the outer surface comprises at least one gripping surface
- Wherein the gripping formation comprises a plurality of ribs
- A sealing formation covering the inlet
- The sealing formation formed from a synthetic plastic
- The sealing formation formed of silicone
- The elongate body is at least partially made of steel

Regarding the gripping formation limitations, Honkanen teaches a surgical cannula comprising a plurality of rib formations (35) disposed on the surface of the cannula (40) in order to enhance the ability of the cannula to remain in place and make a tight seal with the surrounding tissue, without causing excess trauma to the tissue (Column 2, proximate lines 27-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wright as a matter of design choice with the rib formations of Honkanen in order to enhance the ability of the cannula to remain in place and make a tight seal with the surrounding tissue, without causing excess trauma to the tissue.

Regarding the seal formation limitations, Honkanen teaches a surgical cannula comprising a plastic, such as silicone (Column 3, proximate lines 45-55) seal formation (70) in order to seal against annoying fluid backflow both when an instrument is inserted in the cannula and when one is not (column 2, proximate lines 9-14). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wright as a matter of design choice with a silicone seal as taught by Honkanen in order to seal against annoying fluid backflow both when an instrument is inserted in the cannula and when one is not.

Regarding the limitation wherein the elongate body is at least partially made of steel, Honkanen teaches wherein the cannula may be lined with metal near the bottom end of the cannula for use as a drilling device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wright as a matter of design choice with a portion of the cannula made of metal such as steel in order to use the device as a drilling device.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRP  
10/9/06

  
**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**  
11/4/06.